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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,113	12/29/2000	Tomoko Terakado	208366US6 CONT	6754
22850	7590	04/14/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SAJOUS, WESNER	
			ART UNIT	PAPER NUMBER

2676

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,113

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Remarks

This communication is responsive to the amendment and response filed on March 8, 2004. In this response, claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-119 are currently pending in this application, of which claims 109-119 are newly added.

Response to Arguments

1. The Applicants, at pages 25-26 of the response, argues that the combination of Fajkowski and Goldstein is improper and they are results of hindsight reconstruction, because the coupon of Fajkowski is for goods or services and is already the user's possession, and the coupon of Goldstein is for a television viewer seeking cost savings for products he/she is interested in purchasing when viewing a broadcast. It may relate to a discount on a product or pay per view television show.

In response, the Examiner respectfully disagrees, because the applied prior art references are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In this case, Fajkowski teaches the coupon information which is lacking in Goldstein. Thus, the rejection is proper. Further, it is noted that there is no recitation in Applicants' claims that the coupon is related to a discount on a product or pay-per-view television show. The claims merely recite a control device that communicates with a transmitting unit to transmit advertising information that includes coupon information to an electric apparatus. Thus, the rationale for Applicants' arguments is not based on the

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claimed invention. Moreover, with regards to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, the Applicants' arguments are not deemed persuasive. The rejections to claims 33-34, and 37-55 are sustained.

Independent claims 47-49, 53-56, 70, 83 and 95 recite analogous features to claims 33-34, and 37-55; the discussions for claims 33-34, and 37-55 above also applied for claims 47-49, 53-56, 70, 83 and 95.

With regards to the rejections of claims 56-57, 60-71, 74-84, 87-96, 99-108, these rejections are now withdrawn, because the Kishtaka reference does not qualify under 35 USC 102 (a). Kishtaka was filed after the application priority date of July 18, 1997.

Re claim 37, it is noted that the features of the claim were previously addressed with regard to the combination of Goldstein and Fajkowski above, thus it is not necessary to address Applicants' argument herein.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-34, 37-40, 41-55 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein Pat. No. 5410326 in view of Fajkowski, Pat. No. 5905246.

Considering **claims 33-34**, Goldstein, at figs. 1-2, discloses a control device (5) which controls, by transmitting a control signal (27), an electric apparatus (*either of items 6-9*) including an extraction unit (*e.g., a tuner/receiver which is typical in most television set, e.g., item 139 of fig. 14*) and an electric apparatus transmitting unit (*e.g. either of items 85-88 of fig. 14*), the electric apparatus transmitting unit for transmitting additional information (*e.g., advertisement, see abstract and col. 12, lines 14-33*) extracted by the extracting unit to a receiver, that receives information transmitted via a transmission medium (*e.g., an antenna or satellite. See fig. 14*), comprising:

A transmitting unit (29) ... electric apparatus; the receiver (6-9) for receiving additional information (*e.g., advertising, see abstract*) transmitted by the electric apparatus; an output means (*85, fig. 10*) for outputting the additional information received by the receiver to a display device (10); a memory (*90-91, fig. 10*) for storing at least a portion of said additional information (*e.g., advertisements of category programs, see fig. 20*) wherein the additional information include advertisement information included in the information received by the electric apparatus. See col. 4, line 11 through col. 5, line 42, and col. 12, line 11 through col. 14, line 55.

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It is noted that Goldstein fails to teach coupon information is transferred from the first memory to a second memory when the user selects the coupon information, and deleting the information stored in the memory.

Fajkowski in a similar art teaches transferring coupon information from the first memory to a second memory when the user selects the coupon information, and deleting the information stored in the memory. See col. 6, lines 39-59 together with col. 13, lines 37-66, and col. 15, lines 11-12.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the features of Goldstein to include the transfer of coupons records from one storage to another (*e.g., one card to another, see col. 13, lines 37-66*), as taught by Fajkowski; in order to provide a system that allow the consumer or user to instantly receive credit for rebates, while quickly and efficiently supplying the manufacturer with both the demographic data and stimulation power the rebate is intended to provide. See Fajkowski's col. 5, lines 61-65.

As per **claim 38**, the claimed "selecting unit for selecting information...wherein the memory is configured to store the information selected by the selection unit" is met by the functions performed by the remote control 5 of Goldstein upon actuation of any key of the controller device. See col. 7, lines 41-55.

Regarding **claim 39**, it is noted that all the elements recited in claim 39, including the second storing unit the second selecting unit, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Goldstein, which communicates information from and to the remote controller 5 via bi-

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directional link 31 (see col. 7, line 41 to col. 8, line 14), for these components are conventional elements included in a television system.

Re claim 40, Goldstein recording apparatus (7, fig. 1) performs a recording reservation based on information transmitted from the control device (5). See also fig. 13.

As per **claim 41**, the claimed "second electric apparatus is a personal computer, ... accesses a server based on information transmitted from the control device" would have been obvious over Goldstein's col. 8, lines 42-44. It is noted that since the system is capable of transmitting information via a modem to database connected to a local area network, a computer must be used to communicate the information from the LAN.

In **claims 42 and 44**, the claimed "notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device" is met by the display 9, fig. 1 of Goldstein.

Re **claim 43**, the claimed "control device instructs the electric apparatus to transmit the additional information" is characterized by the function of item 89 of fig. 10 of Goldstein.

As per **claims 45 and 46**, the claimed "output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward" would have obvious the system of Darbee, since it enables the user to view program guide, identifying PPV information (see figs. 2-9) select information pertaining to specific genres or categories (see fig. 20) and to retrieve the selected category transmitted from the television set. See col. 3, line 1 through col. 5, line 42.

Claim 47 recites features equivalent to claim 33; it is, therefore, rejected for the same reasons and rationale set forth for claim 33.

Claim 48 is a computer program substantially performing the same method as claim 33; it is, therefore, rejected by the same rationale as claim 33.

The invention of **claim 49**, although slightly different, it recites features capable of performing the same function as claim 33. As the various features of claim 33 have been shown to be obvious over the combined teaching of Goldstein and Fajkowski, it is readily apparent that the apparatus disclosed by the prior art performs the recited underlying functions, because in Goldstein, the remote controller 5 communicates bi-directionally with a television system to transmit signals to and from the other. Hence the television set incorporates the second receiving unit, and it is able to perform operation in accordance with the control signal from the remote controller. Therefore, the limitations recited in claim 49 are rejected under the same rationale as claim 33.

Re **claims 50-51**, the claimed "electric apparatus is a personal computer; a television receiver" is obviously met by the depiction at col. 8, lines 42-56.

The limitation of **claim 52** is met by fig. 1, item 7.

The invention of **claim 53**, although slightly different, it recites features equivalent to claim 49. As such, the limitations of claim 53 are rejected for the same reasons and rationale as claim 49, and incorporated herein.

The invention of **claim 54**, although slightly different, it recites performing functions equivalent to claim 53 and is similarly rejected.

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The invention of **claim 55**, although slightly different, it recites performing functions equivalent to claim 48 and is similarly rejected.

Claim 63 is rejected for reason similar to claim 40.

Re **claims 109-115**, Fajkowski, at col. 6, lines 35-43, discloses the equivalence for providing (e.g., via the Internet) the coupon information to the electric apparatus (e.g., a computer) as a component of a content signal.

3. **Claims 56-57, 60-71, 74-84, 87-96, 99-108** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Fajkowski and further in view of Kishtaka (6084643).

As per **claims 56-57, 61**, the combination of Goldstein and Fajkowski render obvious most claimed features of the invention, as recited in claims 33-34 above, however, it is noted that the combination of Goldstein and Fajkowski fail to particularly suggest an IC card as a detachable storing means.

However, Niimi teaches a detachable IC card memory (see fig. 3, item 20, col. 2, lines 30-35, col. 2, lines 45-54, and col. 3, lines 46-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been motivated to incorporate the features of Goldstein and Fajkowski together with Niimi, wherein an IC card as a detachable storing means is provided, in order to allow the user to check the contents of registered data in the memory without requiring a cumbersome operation. See Niimi's col. 1, lines 54-55.

In **claim 60**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

Regarding **claim 62**, it is noted that all the elements recited in claim 39, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Goldstein, which communicates information from and to the remote controller 5, for these components are conventional elements included in a television system.

As per **claim 64**, the claimed "second electric apparatus is a personal computer, ... accesses a server based on information transmitted from the control device" is obviously met by the description at col. 8, lines 42-44. The Applicant should duly note that since the system transmits information via a modem to a database connected to a local area network, a computer server must be used to communicate the information to the LAN.

In **claims 65 and 67**, the claimed "notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device" is met by item 10 or 9 of fig. 1.

As per **claims 68-69**, the claimed "output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward" is equivalently met by the system of Goldstein, since it enables the user to view program guide, identifying PPV information (see figs. 2-9) select information pertaining to specific genres or categories (see fig. 20)

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and to retrieve the selected category transmitted from the television set. See col. 3, line 1 through 5, line 42.

The invention of **claims 70-71, 74-84, 87-96, and 99-108**, although slightly different, they recite the underlying features of claims 56-69, respectively. As the various features of claims 56-58, and 60-69 have been shown to be obvious in view of the combined teachings of Goldstein, Fajkowski and Kishtaka, it is readily apparent that the apparatus disclosed by the prior art perform the recited underlying functions. As such, the limitations recited in **claims 70-71, 74-84, 87-96, and 99-108** are rejected for the same reasons and rationale given above for claims 56-69. It is noted that since the coupon card suggested in Fajkowski have storage capability to keep coupon records, and it is detached from the main components of the system, it is construed as an IC card, as called for in claim 83.

Re **claims 116-119**, Fajkowski, at col. 6, lines 35-43, discloses the equivalence for providing (e.g., via the Internet) the coupon information to the electric apparatus (e.g., a computer) as a component of a content signal.

4. **Claim 37** is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Fajkowski and further in view of Maa.

Re claim 37, the combination of Goldstein and Fajkowski render obvious most claimed features of the invention, as recited in claims 33-34 above, however, it is noted that the combination of Goldstein and Fajkowski fail to particularly suggest advertisement information includes URL information.

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However, Maa teaches advertisement information includes URL information.

See col. 6, lines 7-30.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been motivated to incorporate the features of Goldstein and Fajkowski together with Maa, in order to enable the system user to access information via the internet.

Conclusion

Any response to this action should be mailed to:

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or faxed to:

(703) 872-9314, (for technology center 2600 only)

Or:

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesner Sajous whose telephone number is (703) 308-

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5857. The examiner can also be reached on Mondays thru Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number for this group is (703) 308-6606.

Wesner Sajous



4/9/2004